

## REMARKS

By this amendment, the drawings, the specification, the abstract, and claims 1-3 and 5-7 have been amended, claim 9 has been canceled in favor of claim 10 to place this application in condition for allowance. Currently, claims 1-8 and 10 are before the Examiner for consideration on their merits.

In the Office Action, the Examiner raised a number of formalities regarding the drawings, claims, specification, and abstract. In addition, claims 1-9 have been rejected under 35 U.S.C. § 102(e) based on United States Patent No. 6,517,580 to Ramadan et al. (Ramadan).

The various issues are addressed below under their respective headings unless addressed previously.

### DRAWINGS

By separate letter to the draftsman, corrected sheets of drawings are submitted herewith. The corrected sheets respond to each and every issue raised in the Office Action about the drawings, and it is respectfully submitted that the drawing informalities have been removed, and the replacement sheets should be entered.

### SPECIFICATION

In the Office Action, the Examiner objected to the lack of reference numerals 8, 11, and 14 in the specification when these numerals were found in the drawings. As part of the submission of corrected drawings, numerals 8, 11, and 14 have been deleted from the drawings. This correction overcomes the objection to the specification in this regard.

The specification has also been revised to include the appropriate headings, and these revisions require withdrawal of the objection as it relates to this item.

Lastly, page 7 of the specification has also been amended to correctly define the “hole 20” rather than the “bearing surface 23”. No new matter is introduced by this amendment, since a clear reading of the drawings supports the change to the specification.

### CLAIMS

In response to the rejection of the claims under 35 U.S.C. § 112, second paragraph, the claims have been amended to correct instances of antecedent basis and to improve the language of the claims. More specifically, claims 2 and 3 have been extensively amended. Claim 9, which corresponded to original claim 3, has been canceled in favor of new claim 10, which parallels amended claim 3. With these changes, each of the instances of a lack of antecedent basis has been corrected, and it is respectfully requested that the rejection of the claims for indefiniteness should be withdrawn.

### PRIOR ART REJECTION

In the rejection, the Examiner contends that Ramadan teaches each and every element of the claims. It is respectfully contended that this assertion is incorrect since, in fact, Ramadan does not include each and every feature of claim 1 and cannot establish a *prima facie* case of anticipation.

Specifically, Ramadan does not teach or suggest the “means for authorizing relative rotation movements between the first and second plates according to an angular clearance limited by means of stop in relative rotation.” Turning to the teachings of Ramadan, there is no limit on

the rotational movement of the plate 2 with respect to the plate 3. That is, these two plates can freely rotate with respect to each other.

The Examiner references col. 3, lines 57-63 to support the allegation that the means for relative rotation and stop are disclosed. This portion of Ramadan has no teaching whatsoever regarding a limitation on the rotation of the cup 8 or cap 6, and cannot act as a basis to reject claim 1. The Examiner also cites Figure 1 to allege that the shape of parts 6 and 8 control relative movement, but this position is also unsubstantiated. Figure 1 can only lead to the conclusion that the cup 8 freely rotates with respect to the cap 6, and vice versa.

Contrasting the invention, claim 1 specifically defines a means for authorizing relative rotation that is limited by means of a stop. This stop is shown in Figures 1-5 as the clearances 32 limiting movement of the axis 31, see also page 8, lines 1-5. That is, when the plate 2 rotates to the cross plane T (or to the axis crossing the front plane F and the sagittal plane S), the rotation movement of the plate 2 is stopped by the interaction between the clearances 32 and axis 31.

In Figures 6-9, the male geometric shape 41 coupled with the female geometric shape controls the rotative movement of the plates 2 and 3, see also page 9, lines 1-9.

Again, no structure is present in Ramadan that achieves this function and this patent cannot anticipate claim 1 for this simple reason.

In a similar vein, dependent claim 5 and 6 are also not found in Ramadan, since these claims further define the stop means, and there are no stop means in Ramadan.

Moreover, there is no motivation to modify Ramadan and arrive at the invention since Ramadan does not in the least present any hint of the need for providing limited rotation movement of the plates with respect to each other. Any allegation of obviousness on this point

can only be the hindsight reconstruction of the prior art in light of Applicants' own disclosure, and such a position cannot support a further rejection of the claims.

The rejection is also flawed since Ramadan does not teach the limitation regarding the prosthesis as a single piece. Claim 1 calls for an assembly means with the first and second plates so as to form a prosthesis that consists of a single piece. This claim limitation is not found in Ramadan since Ramadan has no assembly means that forms a single piece prosthesis. Referring to Figure 1 of Ramadan, it is clear that the spherical cup 8 that is connected to the base 13 and the spherical cap 6 connected to the base 12 lack any means of assembly that would make the cup and cap into a one-piece prosthesis. Since this claim limitation is lacking, the rejection is also unfounded for this reason.

Consistent with the argument regarding the lack of motivation for the rotation stop means, there is also no reason why one of skill in the art would be motivated to modify Ramadan and somehow include an assembly means to make the prosthesis into a single piece. The only source for motivation of this nature would be Applicants' own disclosure and the use of this disclosure as a teaching template to formulate a rejection under 35 U.S.C. § 103(a) is expressly forbidden by case law.

Based on the above, it is absolutely clear that the Examiner has not met the burden imposed by the PTO to establish anticipation or obviousness against claim 1. Therefore, this claim is patentably distinguishable over Ramadan.

It is further submitted that the Examiner has not made out a *prima facie* case of anticipation or obviousness against the dependent claims 2-4, and 7, 8, and 10. Where is the arrangement of the hole and bearing surface of claim 2? While the Examiner points to Figure 5,

how can the mating of the cup and cap of Ramadan be construed to read on a hole locked in place as required by claim 2?

Where are the axis and clearances of claims 3 and 10, and the clearances of claim 4 in Ramadan? The Examiner alludes to Figures 2 and 3 to allege that an axis is shown, but these Figures do not whatsoever show an axis as is detailed in these claims.

Where is the insert ring of claims 7 and 8? While the Examiner alleges that item 8 of Ramadan is a ring, there is no basis to draw this conclusion. Item 8 is a spherical cup not a ring.

While claim 1 has been demonstrated to be patentable over Ramadan, the arguments above also show that each of claims 2-9 is separately patentable over the teachings of Ramadan.

#### SUMMARY

In summary, it is respectfully contended that all claims are fully definite under the purview of 35 U.S.C. § 112, second paragraph, the drawings are satisfactory, and the specification and abstract are in order. Thus, all objections/rejections regarding these items should be withdrawn.

Further, it is contended that the Examiner has failed to establish a *prima facie* case of anticipation or *prima facie* case of obviousness against claims 1-8 and 10 and that each of these claims is patentable over Ramadan.

Therefore, the Examiner is respectfully requested to examine this application in light of this amendment, and pass claims

If the Examiner believes that an interview with Applicants' attorney would expedite allowance of this application, the Examiner is respectfully requested to telephone the undersigned at 202-835-1753.

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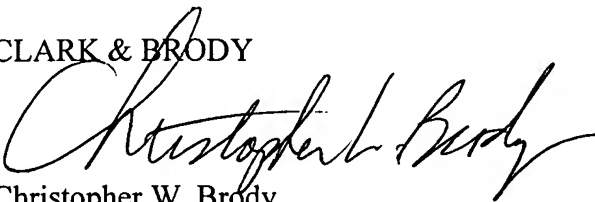
The above constitutes a complete response to all issues raised in the Office Action dated December 21, 2004.

Again, reconsideration and allowance of this application is respectfully requested.

Applicants petition for a one month extension of time. The extension of time fee of \$60.00 is attached herewith by check. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 50-1088.

Respectfully submitted,

CLARK & BRODY

A handwritten signature in black ink, appearing to read "Christopher W. Brody", written over the printed name.

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